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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,144	12/11/2003	Nicholas G. Niejelow	OPT100013000	8265
22891	7590	10/21/2004	EXAMINER	
DELIO & PETERSON 121 WHITNEY AVENUE NEW HAVEN, CT 06510			AFTERGUT, JEFF H	
			ART UNIT	PAPER NUMBER

1733

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/733,144

Applicant(s)

NIEJELOW ET AL.

Examiner

Jeff H. Aftergut

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-4, 6-10, 12, 13, 15-18, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbin et al in view of Salamon and Lipman for the same reasons as expressed in the Office action dated July 28, 2004, paragraph 2.

With regard to newly added claims 21 and 22, note that the reference to Salamon et al suggested that the assembly after use was deblocked, i.e. the protective film, the adhesive and the block were all separated from the lens to leave the lens alone and free of adhesive or other blemishes. Note that this is what would have been understood to have been performed with the protective films of Herbin et al. Additionally, note that the ordinary artisan would have expected that cling film of Lipman would have been removed after the deblocking operation without leaving any marks on the surface as such is a function of using the cling film, see claims 23 and 24.

3. Claim 5, 11, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with Kassab for the same reasons as expressed in the Office action dated July 28, 2004, paragraph 3.
4. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with Parish, Jr. et al (newly cited).

While the references as set forth above in paragraph 2 suggested that the protective film would have been removed subsequent to the blocking operation, to further evidence that such is the case, the reference to Parish et al is cited. Parish suggested that one skilled in the art would have provided a protective film which was removed subsequent to the blocking operation which left no residue on the lens subsequent to the grinding operation, see column 8, lines 45-53. Clearly, one skilled in the art at the time the invention was made would have known how to formulate film materials as well as adhesives which were capable of protecting the lens surface which were subsequently removed without leaving any residue on the lens. It would have been obvious to one of ordinary skill in the art at the time the invention was made to deblock the assembly after processing wherein the lens was left protected in the blocking operation and free of any scratches and residue after deblocking and removal of the protective film as suggested by Parish, Jr. et al in the operation of grinding a lens as set forth above in paragraph 2.

### ***Response to Arguments***

5. Applicant's arguments filed September 7, 2004 have been fully considered but they are not persuasive.

The applicant essentially argues that the reference to Lipman requires that there be an opening in the cling film and that this teaches away from the suggestion of Herbin et al of using a protective film in the operation of blocking a lens. The applicant also argues that there is an unexpected benefit in that the cling film was better able to facilitate the bonding of the adhesive on the block to the lens than attempting direct

contact which was difficult with the special anti-reflective coatings provided on the lens. These arguments are not persuasive for the reasons discussed in detail below.

Regarding the argument that Lipman taught away from the use of a cling film disposed between the adhesive of the block and the lens surface, the applicant is advised that the rejection is NOT using the cut film of Lipman but rather is using the evidence within the Lipman document which clearly suggested that as an alternative to an adhesive coated film one skilled in the art would have recognized that the use of a cling film would have been a functional equivalent alternate expedient for the protection of the lens surface. The applicant is advised that where, as here, two equivalents are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious, In re Fout, 213 USPQ 532, In re Siebentritt, 152 USPQ 618. The reference to Lipman expressly stated that the protective film used to protect the lens from damage in the grinding operation was either a cling film or an adhesive coated film, see column 4, lines 56-59 of Lipman. It should be noted that the reference to Herbin et al clearly suggested that the protective film was applied over the entire surface of the lens wherein the protective film was an adhesive coated film, see column 1, lines 11-19, column 3, lines 34-37, column 3, lines 48-50. The applicant is advised that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a cling film in place of an adhesive coated film in the operation of Herbin in light of the teachings of Lipman that such cling films would have been art recognized functionally equivalent alternate expedients. It should additionally be noted that while the reference

to Lipman did in fact provide an opening in the cling film, it is not readily apparent from a reading of the reference why such an opening was provided. One skilled in the art would have understood that the blocking operation would have worked whether there was a protective film over the area where the block was joined to the lens with adhesive or not. The references to Herbin and Salamon et al both suggested that the grinding operation would have taken place with the adhesive in direct contact with the protective film. Thus, those skilled in the art would have known to use the protective film with either the opening or with the film in tact (without the opening therein) in the blocking operation and would have selected a suitable cling film for the operation depending upon the requirements of the protection.

Regarding the arguments relating to the use of the anti-reflective coatings, the applicant is advised that the use of antireflective coatings on the lenses was taken as conventional in the art. The applicant did not dispute this Official Notice and therefore it is believed applicant has acquiesced the same. The applicant is advised that while the adhesive of the block may not have bonded well to the antireflective coatings on the lenses, the prior art of record (the closest prior art) suggested that one skilled in the art would have joined a protective film to the surface of the lens with an adhesive such as an adhesive tape from 3m Company identified as 1641 by Herbin (column 3, lines 48-50). The applicant is advised that it is this film surface which is then joined to the adhesive disposed on the block. As such, applicant has not provided a comparison of the closest prior art to the claimed invention. Namely, one must compare the adhesive strength of the block to the lens with the protective adhesive film (tape) joined to the

lens as taught by Herbin in comparison to the adhesive strength achieved with the cling film of the invention. It should be noted that only those claims which recite the use of the antireflective coating are commensurate in scope with the arguments presented in this regard (such as claim 8 while claims 1 and 15 are not commensurate in scope with the arguments presented in this regard).

### ***Conclusion***


6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeff H. Aftergut  
Primary Examiner  
Art Unit 1733

JHA  
October 19, 2004